

## **REMARKS**

As a preliminary matter, during a telephone conversation with the examiner on 10/23/02 regarding the 10/28/2002 restriction requirement, claims 1-5 were elected for prosecution with traverse and claims 6-30 were cancelled without prejudice--confirmation of which is hereby provided. In this response, claims 1-5 remain pending. Claims 1-4 have been amended. Claims 31-40 have been added. No claims have been cancelled. In view of the following remarks, withdrawal of the outstanding rejections and allowance of the pending claims is respectfully requested.

A previous response to the October 28, 2003 Office Action included a number of arguments that are pertinent to the current 35 USC §112, second paragraph rejections in the March 26, 2003 Office Action (hereinafter referred to as the "ACTION"), to which this communication is responsive. These arguments are useful to illustrate that the subject matter of the pending claims would be clear to one of ordinary skill in the art in view of the supporting specification. Those arguments are not repeated verbatim herein, but instead are incorporated by reference. The Office is urged to reconsider those arguments in view of the following arguments.

### **35 USC §112**

Claims 1-5 stand rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is traversed.

In addressing claim 1, the ACTION asserts that "[h]aving an edge as defined in the specification would mean that it [the sheet] would have to be a three dimensional article, not a sheet." The ACTION supports this assertion by

arguing that an edge is not what the supporting specification clearly describes, but rather must take on a particular meaning, such as that used in a prior art reference. Such substitution of another meaning for what is clearly described in the specification is contrary to well-established axioms of patent law and  
5 Patent Office procedure.

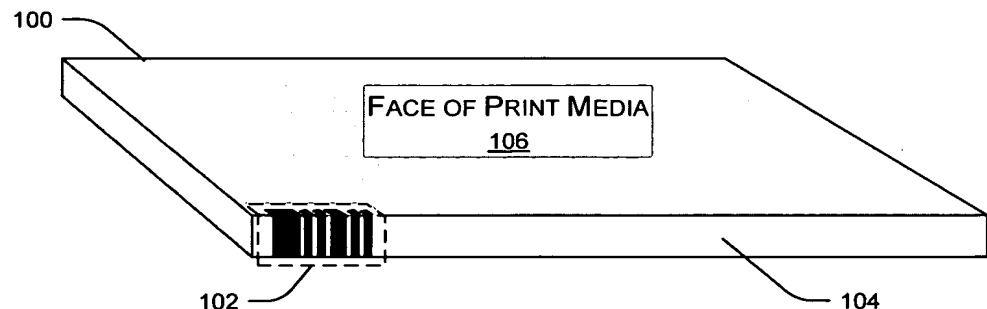
“[A] patentee is free to be his or her own lexicographer, a patentee may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings”—(see, the MPEP §2173.05(b). Accordingly, the manner in which the supporting application describes structural aspects of a sheet of  
10 print media (via edge and facial portions) is not improper or “repugnant”, as asserted by the ACTION. This is a well-established axiom, even in view of *In re Hill*, case law that was cited by the ACTION).

Additionally, it is a fundamental aspect of patent application examining procedure (MPEP §2111.01) that during examination plain meaning is given to  
15 a claimed term unless the specification provides meaning for the term, whereupon which the specification must be used to identify the meaning ascribed to the term by the inventor. Accordingly, if the Office finds that certain terms are unclear because terminology used in the supporting specification was not commonly used in a particular prior art reference, the  
20 Office has been provided with procedural guidance and is to refer to the supporting specification for clarification. In this particular case, the supporting specification clearly describes, with particularity and precision, the edge and facial portions of a sheet of print media.

**Claim 1** recites a sheet of print media including “facial portions”, “edge  
25 portions”, “a single fluid-based marking, the single fluid-based marking being positioned on a facial portion of the facial portions and on an edge portion of the edge portions, the edge portion being adjacently positioned and

substantially perpendicular to the facial portion”, and “wherein the single fluid-based marking comprises data for configuring an imaging device from the facial portion and/or from the edge portion.”

A person of ordinary skill in the art, when reading claim 1 in view of the supporting specification would be able to ascertain that “a sheet of print media” with “an edge portion” that is “adjacently positioned and substantially perpendicular to the facial portion” is a 3-dimensional sheet (not a two-dimensional object as indicated by the ACTION). Additionally, Fig. 1 of the supporting specification, which for purposes of convenience is shown below, clearly illustrates with particularity and precision the position of “an edge portion” 104 of a sheet 100 as compared to the position of “a facial portion” 106 of the sheet. As plainly shown, edge 104 does not lie on the same plane as a facial portion 106. Rather, “edges” are positioned at substantially perpendicular orientation to the “facial portions” of “a sheet”.  
15



*Fig. 1*

Since the supporting specification clearly describes the terms “edge portion” and “facial portion”, a person of ordinary skill in the art, when reading claim 1 in view of the supporting specification would be able to ascertain with

a reasonable degree of precision and particularity the specific area set out and circumscribed by claim 1. Accordingly, and for each of the above reasons, the 35 USC §112, second paragraph rejection of claim 1 should be withdrawn.

**Claim 2** recites “wherein for each facial portion of the facial portions, a  
5 single respective fluid-based marking is positioned on the facial portion and on an adjacent and substantially perpendicular edge portion of the edge portions”, and “wherein individual ones of the fluid-based markings comprise data for configuring operations of the imaging device to form images on the sheet.”

For each of the reasons discussed above with respect to claim 1, from  
10 which claim 2 depends, a person of ordinary skill in the art, when reading claim 2 in view of the supporting specification would be able to ascertain with a reasonable degree of precision and particularity the specific area set out and circumscribed by the claim.

Accordingly, the 35 USC §112, second paragraph rejection of claim 2  
15 should be withdrawn

**Claim 3** recites “wherein the single respective fluid-based marking was imprinted on the edge portion and not imprinted on the facial portion, the fluid-based marking having bled onto the facial portion.”

For each of the reasons discussed above with respect to claim 1, from  
20 which claim 3 depends, a person of ordinary skill in the art, when reading claim 3 in view of the supporting specification would be able to ascertain with a reasonable degree of precision and particularity the specific area set out and circumscribed by the claim.

Accordingly, the 35 USC §112, second paragraph rejection of claim 3  
25 should be withdrawn

**Claim 4** recites “wherein the single fluid-based marking is ink.” For each of the reasons discussed above with respect to claim 1, from which claim 4

depends, a person of ordinary skill in the art, when reading claim 4 in view of the supporting specification would be able to ascertain with a reasonable degree of precision and particularity the specific area set out and circumscribed by the claim.

5           Accordingly, the 35 USC §112, second paragraph rejection of claim 4 should be withdrawn

**Claim 5** recites “[a] stack of print media comprising a plurality of sheets, each sheet being a sheet as recited in claim 1.” For each of the reasons discussed above with respect to claim 1, a person of ordinary skill in the art, 10 when reading claim 5 in view of the supporting specification would be able to ascertain with a reasonable degree of precision and particularity the specific area set out and circumscribed by the claim.

          Accordingly, the 35 USC §112, second paragraph rejection of claim 5 should be withdrawn

15

**Conclusion**

Pending claims 1-5 and 31-40 are in condition for allowance and action to that end is respectfully requested. If any questions remain that prevent issuance of this application, the office is invited to contact the undersigned.

20

Respectfully Submitted,

Dated: 6/26/03

By: Brian G. Hart

25

Brian G. Hart  
Reg. No. 44,421  
Lee & Hayes, PLLC  
(509) 324-9256